UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,996	11/26/2003	Robert J. Polilli	600181-018	7980

61834   7590   04/29/2008
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EXAMINER
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ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
04/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/723,996	POLILLI ET AL.
	Examiner	Art Unit
	KRISTINE K. RAPILLO	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 November 2003</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-20</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>26 November 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>4/26/2004; 4/17/2006</u>.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Claims 1 – 20 are pending.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine; an article of manufacture; or a composition of matter. However, claim 1 does not seem to fall within one of these recognized categories. The method as claimed can be performed in the mind of a user, by paper and pencil, or by a machine. These steps constitute an idea of how to provide juvenile insurance. One may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent in practical effect, would be a patent of the [abstract idea] itself." Benson, 409 U.S. at 71-72, 175 USPQ at 676; cf. Diehr, 450 U.S. at 187, 209 USPQ at 8.

        The above deficiency can be overcome by expressly stating a method which limits claim 1 to sales, for example, which makes the claim useful.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 2 – 6, 8 – 11, 13 – 14, and 17 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over ICICI Prudential Life Insurance SmartKid website, hereinafter SmartKid (2002;

(http://web.archive.org/web/20030711211642/iciciprulife.com/creative/blankproduct.jsp?productid=169))

in view of Spinar ("An Argument for Children's Insurance." Life Association News. Washington: May

1993. Vol. 88, Iss. 5; page 126, 3 pages).

In regard to claim 1, SmartKid teaches a method for providing juvenile insurance having a waiver of

premium feature comprising: determining one of a premium and a death benefit for the potential payor,

the premium or death benefit computed based at least in part on a variable that is not directly dependent

on at least one of age, health, and gender of the potential payor (paragraphs 11 - 12 and 18 – 20) where

the premium can be increased based on need (i.e. education).

SmartKid fails to teach a method comprising obtaining information useful for issuing a juvenile

insurance policy for a potential payor and an insured.

Spinar teaches a method of obtaining information useful for issuing a juvenile insurance policy for a

potential payor and an insured (paragraph 5) where useful information is interpreted as information

regarding a parent's life insurance policy.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to include a method of obtaining information useful for issuing a juvenile insurance policy for a

potential payor and an insured as taught by Spinar with the motivation of providing insurance protection

on a child (Spinar: paragraph 1).

In regard to claim 2, SmartKid teaches the method of providing juvenile insurance as per claim 1.

SmartKid fails to teach a method comprising determining one of a premium and a death benefit

computed based at least in part on a probability associated with an incidence of an event that triggers the

waiver of premium feature occurring to an individual of the group of acceptable payors based on at least

one eligibility requirement or a subset of the group of acceptable payors.

Spinar teaches a method comprising determining one of a premium and a death benefit computed

based at least in part on a probability associated with an incidence of an event that triggers the waiver of

premium feature occurring to an individual of the group of acceptable payors based on at least one

eligibility requirement or a subset of the group of acceptable payors (paragraph 25).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to include a method comprising determining one of a premium and a death benefit computed

based at least in part on a probability associated with an incidence of an event that triggers the waiver of

premium feature occurring to an individual of the group of acceptable payors based on at least one

eligibility requirement or a subset of the group of acceptable payors as taught by Spinar with the

motivation of providing economic protection for a child in the event of death of the parent or individual

paying for the policy (paragraph 1).

In regard to claim 3, SmartKid teaches the method of claim 2, wherein the eligibility requirement

requires a payor to be associated with a group of individuals having at least one commonality between

them (paragraph 4) where the group of individuals are parents (i.e. they all share the role of parent, thus a

common thread is illustrated between the individuals).

In regard to claim 4, SmartKid teaches the method of claim 2, wherein the eligibility requirement

comprises at least one of a maximum age and a generational qualification for payors (paragraph 4).

In regard to claim 5, SmartKid teaches the method of claim 2, wherein the waiver of premium feature

is a standard feature of the juvenile insurance policy (paragraph 11)

In regard to claim 6, SmartKid teaches the method of claim 2, wherein the event that triggers the

waiver of premium feature comprises death of the payor (paragraphs 9 and 11).

In regard to claim 8, SmartKid teaches the method of claim 2, comprising:

- determining one of a premium and a death benefit for the potential payor, the premium and death

  benefit computed based at least in part on the potential payor's affiliation with a group of

individuals having at least one commonality between them (paragraph 4) where the group of

payors with commonality are parents, and

- a probability associated with an incidence of an event that triggers the waiver of premium feature

  occurring to an individual of the group of individuals having at least one commonality between

  them or a subset of the group of individuals having at least one commonality between them given

  at least one of the age and gender of the insured (paragraphs 6 and 7) which illustrates different

  pricing schemes based on the age of the child.

In regard to claim 9, SmartKid teaches the method of claim 8, wherein the premium and death benefit

do not vary based on at least one of an age, health, or gender of the potential payor (paragraph 8).

In regard to claim 10, SmartKid teaches the method of claim 2, wherein the probability of an incidence

of the event that triggers the waiver of premium feature accounts for at least one limitation for exercising

the waiver of premium feature selected from a group consisting of a 2-year waiting period, a generational

qualification, and an age limit for the insured (paragraph 4) where a minimum and maximum age limit of

the parents determines qualification.

In regard to claim 11, SmartKid teaches the method of claim 2.

SmartKid fails to teach a method wherein the premium and death benefit are determined based at

least in part on the probability of an incidence of an event that triggers the waiver of premium feature

accounting for the blend of the individuals of the group of acceptable payors with regard to at least one of

age, gender, and generational qualification.

Spinar teaches a method wherein the premium and death benefit are determined based at least in

part on the probability of an incidence of an event that triggers the waiver of premium feature accounting

for the blend of the individuals of the group of acceptable payors with regard to at least one of age,

gender, and generational qualification (paragraphs 23 - 25).

The motivation to combine the teachings of SmartKid and Spinar is discussed in the rejection of claim 2, and incorporated herein.

In regard to claim 13, SmartKid teaches a method for providing juvenile insurance having a waiver of premium feature comprising determining whether the potential payor belongs to a group of acceptable payors based on eligibility requirements (paragraph 4).

SmartKid fails to teach a method comprising obtaining information useful for issuing a juvenile insurance policy for a potential payor and an insured that comprises at least one of an age of the insured and a gender of the insured; and determining one of a premium and a death benefit for the potential payor, the premium and death benefit computed based at least in part on the payor's affiliation with the group of individuals having at least one commonality between them, at least one of the age and gender of the insured, and a probability associated with an incidence of an event that triggers the waiver of premium feature occurring to an individual of the group of individuals having at least one commonality between them or a subset of the group of individuals having at least one commonality between them given at least one of an age and gender of the insured, wherein the event that triggers the waiver of premium feature comprises death of the payor.

Spinar teaches a method comprising:

- obtaining information useful for issuing a juvenile insurance policy for a potential payor and an insured that comprises at least one of an age of the insured and a gender of the insured (paragraph 5); and

- determining one of a premium and a death benefit for the potential payor, the premium and death benefit computed based at least in part on the payor's affiliation with the group of individuals having at least one commonality between them, at least one of the age and gender of the insured (paragraph 13) where the group can be defined by age (i.e. newborns), and a probability associated with an incidence of an event that triggers the waiver of premium feature occurring to an individual of the group of individuals having at least one commonality between them or a subset of the group of individuals having at least one commonality between them given

at least one of an age and gender of the insured, wherein the event that triggers the waiver of

premium feature comprises death of the payor (paragraphs 23 - 25).

The motivation to combine the teachings of SmartKid and Spinar is discussed in the rejection of claim

1, and incorporated herein.

In regard to claim 14, SmartKid teaches a method for providing juvenile insurance having a waiver of

premium feature comprising determining whether the potential payor belongs to a group of acceptable

payors based on eligibility requirements (paragraph 4).

SmartKid fails to teach a method for obtaining information useful for issuing a juvenile insurance

policy for a potential payor and an insured and determining one of a premium and a death benefit for the

potential payor, the premium or death benefit being computed based at least in part on a probability

associated with an incidence of an event that triggers the waiver of premium feature occurring to an

acceptable payor.

Spinar teaches a method for obtaining information useful for issuing a juvenile insurance policy for a

potential payor and an insured (paragraph 5) and determining one of a premium and a death benefit for

the potential payor, the premium or death benefit being computed based at least in part on a probability

associated with an incidence of an event that triggers the waiver of premium feature occurring to an

acceptable payor (paragraphs 23 -25).

The motivation to combine the teachings of SmartKid and Spinar is discussed in the rejection of claim

2, and incorporated herein.

In regard to claim 17, SmartKid teaches the method of claim 15, the subset of the group of individuals

having at least one commonality between them comprises individuals of the group able to purchase

juvenile insurance based on limitations for insurability comprising age and generational qualifications

(paragraph 4).

In regard to claim 18, SmartKid teaches the method of claim 15, wherein the waiver of premium feature is a standard feature of the juvenile insurance policy (paragraph 11).

In regard to claim 19, SmartKid teaches the method of claim 15, wherein the event that triggers the waiver of premium feature comprises death of the payor (paragraphs 9 and 11).

5.   Claims 7, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over SmartKid and Spinar, and further in view of Keller et al. (U.S. Publication Number 2003/0093304 A1), herein after Keller.

In regard to claim 7, SmartKid teaches the method of claim 6.

SmartKid fails to teach a method wherein the probability associated with an incidence of an event that triggers the waiver of premium feature for an individual of the group of acceptable payors or the subset of the group of acceptable payors is determined based on mortality data for the group of acceptable payors or the subset of the group of acceptable payors, respectively.

Spinar teaches a method wherein the probability associated with an incidence of an event that triggers the waiver of premium feature for an individual of the group of acceptable payors (paragraph 25).

Spinar fails to teach a method where the subset of the group of acceptable payors is determined based on mortality data for the group of acceptable payors or the subset of the group of acceptable payors, respectively mortality table or data.

Keller teaches a method where the subset of the group of acceptable payors is determined based on mortality data for the group of acceptable payors or the subset of the group of acceptable payors, respectively mortality table or data (figure 18 and paragraph [0072]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the mortality data is used for the group of acceptable payors or the subset of the group of acceptable payors, respectively as taught by Keller with the motivation of

providing a means for evaluating the risk of insurance based on the risk of mortality of the policy

purchaser (paragraph [0078]).

In regard to claim 12, SmartKid and Spinar teach the method of claim 1. SmartKid and Spinar fail to

teach a method wherein the premium and death benefit are computed based at least in part on an anti-

selection factor.

Keller teaches a method wherein the premium and death benefit are computed based at least in part

on an anti-selection factor (paragraph [0084]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to include a method wherein the premium and death benefit are computed based at least in

part on an anti-selection factor as taught by Keller with the motivation of providing a means for evaluating

the coverage available to an individual purchasing a policy (paragraph [0085]).

In regard to claim 15, SmartKid teaches a method for providing juvenile insurance having a waiver of

premium feature comprising determining one of a premium and a death benefit for a juvenile insurance

policy for a potential payor (paragraphs 11 and 18 – 20), the premium and death benefit computed for

each of a plurality of possible issue ages of an insured based at least in part on the payor's affiliation with

a group of individuals having at least one commonality between them (paragraph 4), and offering the

juvenile insurance policy at one of the premium and death benefit based on the age of the insured

(paragraphs 5 – 7).

SmartKid fails to teach a method comprising a probability associated with an incidence of an event

that triggers the waiver of premium feature occurring to an individual of one of the group of individuals

having at least one commonality between them and a subset of the group of individuals having at least

one commonality between them.

Spinar teaches a method comprising a probability associated with an incidence of an event that

triggers the waiver of premium feature occurring to an individual of one of the group of individuals having

at least one commonality between them and a subset of the group of individuals having at least one

commonality between them (paragraph 19).

The motivation to combine the teachings of SmartKid and Spinar is discussed in the rejection of claim

1, and incorporated herein.

In regard to claim 20, SmartKid teaches the method of claim 15.

SmartKid fails to teach a method wherein the probability associated with an incidence of an event that

triggers the waiver of premium feature for an individual member of one of the group of individuals having

at least one commonality between them and a subset of the group of individuals having at least one

commonality between them is determined based on mortality data for one of the group of individuals

having at least one commonality between them and the subset of the group of individuals having at least

one commonality between them, respectively.

Spinar teaches a method wherein the probability associated with an incidence of an event that

triggers the waiver of premium feature for an individual member of one of the group of individuals having

at least one commonality between them (paragraph 19) and a subset of the group of individuals having at

least one commonality between them is determined based on mortality data for one of the group of

individuals having at least one commonality between them and the subset of the group of individuals

having at least one commonality between them, respectively (paragraph 19). Spinar fails to teach

mortality data.

Keller teaches a method of using mortality data to determine a commonality between a group of

individuals (paragraph 2).

The motivation to combine the teachings of SmartKid, Spinar, and Keller is discussed in the rejection

of claim 7, and incorporated herein.

6.   Claim 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over SmartKid and

Spinar, Keller, and further in view of Weiss et al. (U.S. Publication Number 2004/0078242 A1).

In regard to claim 16, SmartKid, Spinar, and Keller teach the method of claim 15 wherein the group of individuals having at least one commonality between.

SmartKid, Spinar, and Kellar fail to teach the commonality comprising members of the AARP.

Weiss et al. teaches a method where a group of individuals having at least one commonality between them comprises members of the AARP (paragraph [0010]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method where a group of individuals having at least one commonality between them comprises members of the AARP as taught by Weiss with the motivation to provide a contracting entity for obtaining an insurance policy (paragraph [0014]).

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Olson ("Life Insurance and the Child." Manager's Magazine. Farmington: Nov 1980. Vol. 55, Iss. 11, p. 26). Olson teaches the use of mortality tables for the issuance of juvenile insurance.

- Sexton et al. (U.S. Patent Number 5,752,236) describes a life insurance method and system which relate to an insurance plan with at least two separate contracts which include death premium benefits, age of insured, events (death of insured), and more.

- "Insurance Policies for Children: Good Investment Cover too." Businessline. Chennai: Feb 24, 2002. pg 1 teaches a life insurance policy on a child which is paid for by another. The article discloses several types of policies offered by the Life Insurance Company of India in which the premium is based on the age of the payor at the time the policy is enacted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/Robert Morgan/
Primary Examiner, Art Unit 3626